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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,329	08/01/2003	Masahito Yoshida	01272.020527.1	3590
5514	7590	01/07/2005		
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER VO, ANH T N	
			ART UNIT 2861	PAPER NUMBER
DATE MAILED: 01/07/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/632,329

Applicant(s)

YOSHIDA ET AL.

Examiner

Anh t.n Vo

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2861

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-85 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-85 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 10/171649; 10/171648; 10/171629.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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NON-FINAL REJECTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The references cited on PTO 1449 have been considered

Double patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-85 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of US Pat. number 6,783,215. Although the

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conflicting claims are not identical, they are not patentably distinct from each other because they claim an inkjet printing apparatus comprising:

- an ink tank;
- an ink container having an ink containing body;
- a part;
- a housing;
- internal volume changing means;
- pressure adjustment;
- a negative pressure;
- meniscus;
- a gas or a liquid as a medium;
- a channel;
- a channel opening and closing unit;
- a pressure regulating unit;
- an inner space of the housing is pressurized to decrease the internal volume;
- the inner space of the housing is depressurized to increase the internal volume.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Citation of Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art references (US Pat. 5,719,609; US Pat. 5,923,353; US Pat. 6,494,568; UA Pat. 6,536,885; US Pat. 6,663,233; US Pat. 6,733,114) cited in the PTO 892 form show an ink jet recording apparatus which is deemed to be relevant to the present invention. These references should be reviewed.

Allowable Subject Matter

Claims 1-30 and 71-72 would be allowable if provide a terminal disclaimer. These claims would be allowable because none of the prior art references of record discloses an ink jet printing apparatus comprising an internal volume changing means for applying a force to a second ink tank such that the internal volume of the second ink tank is reduced to return the ink contents of the second ink tank to a first ink tank in the combination as claimed.

Claims 31-58 would be allowable if provide a terminal disclaimer. These claims would be allowable because none of the prior art references of record discloses an ink container comprising a regulating means that is provided in a housing such that it can regulate the displacement of a part of an ink containing body in the direction of increasing the internal volume to a predetermined position in the combination as claimed.

Claims 59-61 would be allowable if provide a terminal disclaimer. These claims would be allowable because none of the prior art references of record discloses an ink supplying method for supplying ink to an ink container accommodating an ink containing body capable of containing the ink therein and capable of generating a negative pressure by an elastic force from an ink tank serving the ink to be supplied to a printing head, said method comprising a step of regulating the expansion of an ink containing body by using displaceable regulating means, thereby stopping the introduction of the ink in the combination as claimed.

Claims 62-70, 73-74 and 77-83 would be allowable if provide a terminal disclaimer. These claims would be allowable because none of the prior art references of record discloses an ink jet printing apparatus comprising a regulating means that is provided in a housing such that it can regulate the expansion of an ink containing body, wherein the regulating means is configured to regulate the expansion so as to satisfy an equation: $P_{st} = N_t$, where P_{st} represents the negative pressure generated by the ink containing body and N_t represents an ability to hold menisci formed at an ink ejecting portions of a printing head in the combination as claimed.

Claims 75-76 and 84-85 would be allowable if provide a terminal disclaimer. These claims would be allowable because none of the prior art references of record discloses an ink jet

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printing apparatus comprising means for stopping the introduction of ink by regulating the expansion of an ink containing body with regulating means that can be displaced and for substantially achieving equilibrium between an ability to hold menisci formed at ink ejecting portions of a printing head and the negative pressure generated by said ink containing body in the combination as claimed.

CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Anh Vo, whose telephone number is (571) 272-2262.

The examiner can normally be reached on Tuesday to Friday from 9:00 A.M. to 7:00 P.M..

The fax number of this Group 2800 is (703) 872-9306.


ANH T.N. VO
PRIMARY EXAMINER
January 5, 2005